

(c) REMARKS

The claims are 1-4 and 18-36 with claims 1, 18, 24, 25 and 26 being independent. Claims 5-17 have been cancelled. Claim 3 was amended to better define the claimed invention. Claim 32 was amended to correct a formal matter. Reconsideration of the claims is requested.

The Examiner has noted claims 1-40 are in the application. However, only claims 1-36 were originally filed. Accordingly, applicants will treat the Office Action as applied to claims 1-36.

The claims were deemed an obviousness-type double patenting over claims 1-16 of Honma '743, with specific note made of formula (4), claim 2 of the '743 patent compared to present claim 1, where  $R_x$  is phenyl or thienyl and in present claim 3,  $R_1$  of formula (8) is  $(CH=CH_2)$ . Claims 1-18 were rejected as anticipated by Honma '743 under Rule 102 (e).

The claims were also deemed an obviousness-type double patenting over claims 1-40 of Application No. 10/531,226, noting that when  $R_x$  in present claim 3 is formula (8), then  $R_1$  is  $COOR^1$  and  $R^1$  is H, Na or K. The grounds of rejection are respectfully traversed.

Initially, present claim 3 has been amended to delete the  $CH_2=CH_2$  group. In addition, present claim 3 in formula (8) specifically recites that the  $R_1$  substituent, when  $COOR^1$ , is excluded from the para-position of the phenyl group. Claim 1 does not recite any carboxy substituent on a phenyl group. In Application No. 10/531,226, the polyhydroxyalkanoate requires the presence of a para-substituted carboxy group on the phenyl group (i.e. a 4-carboxy-substituted phenyl). Since a para-substituted carboxy is

excluded in claim 3 and not recited in claim 1 there is no overlap between the respective claims and the double patenting rejection should be withdrawn.

With regard to Honma '743, the claimed invention therein requires a 4-vinyl phenyl substituent in formula (1). That compound is not claimed in the present invention, since no para-phenyl substituent is in present formula (8) in claim 3 and the vinyl group is not recited in claim 1. Accordingly, there is no double patenting and no anticipation based on Honma '743 since its claims require a 4-vinyl phenyl group on the alkanoate unit. The present invention does not recite a 4-vinyl phenyl unit in claim 1 and such a unit in claim 3 is not present. If need be, claim 1 can be amended to specifically exclude the vinyl substituted phenyl.

The claims should be allowed and the case passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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